

Appeal Brief

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Electronic Signature for Justin S. Cohen: /Justin S. Cohen/

Docket No.: 66703-0002
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Christopher L. Knauft et al.

Application No.: 09/456,793

Confirmation No.: 6923

Filed: December 8, 1999

Art Unit: 2176

For: SYSTEM AND METHOD OF
DYNAMICALLY GENERATING INDEX
INFORMATION

Examiner: M. Nguyen

APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This appeal is from the decision of the Primary Examiner in the Office Action dated February 3, 2009 ("Office Action"), rejecting claims 1-27, which are reproduced in an Appendix to this brief. The Examiner issued the Office Action in response to a Notice of Appeal filed on August 2, 2007, and an Appeal Brief that was filed on October 2, 2007. Accordingly, the Notice of Appeal filed on April 28, 2009, and this Appeal Brief, constitute a reinstatement of the previous appeal, as explained in MPEP § 1204.01. This application was filed December 8, 1999.

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I. REAL PARTY IN INTEREST

The real party in interest is Idearc Media Corp., Assignee, a corporation organized and existing under the laws of the state of Delaware, and having a place of business at 2200 W. Airfield Dr., P.O. Box 619810, DFW Airport, Texas, 75261-9810.

II. RELATED APPEALS AND INTERFERENCES

Applicants (hereinafter “Appellants”) are not aware of any related appeals or interferences that would affect the Board’s decision on the current appeal.

III. STATUS OF CLAIMS

Claims 1-27 are pending and are the subject of this appeal. Claims 1, 12, 19, and 25 are independent claims. No claims have been canceled or withdrawn.

IV. STATUS OF AMENDMENTS

Appellants did not propose any amendments to this application following the Office Action.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The presently claimed invention includes various methods, systems, and computer programs disposed on computer readable media. The following is a concise explanation of the subject matter defined in each of the claims involved in the appeal, as required by 37 C.F.R. § 41.37(c)(1)(v). In general, the following explanation is not intended to be used to construe or limit the claims, which are believed to speak for themselves, nor do Appellants intend the following explanation to modify or add any claim elements, or to constitute a disclaimer of any equivalents to which the claims would otherwise be entitled, nor is any discussion of certain preferred embodiments herein intended to disclaim other possible embodiments. References herein to the Specification are intended to be exemplary and not limiting. Reference numbers provided below are reference numbers used in Appellants' specification and drawings.

A. Claim 1

Claim 1 recites a computerized method of providing index information for secure audiovisual objects to a search engine system. The method comprises converting at least a portion of a secure audiovisual object into index information, wherein the index information is structured for use in an index database of a search engine system. For example, as described in the Specification referring to state 512 of Figure 5, a server computer converts all or selected portions of the source data object into machine readable characters that will collectively comprise an initial set of index information for the source data object. (Specification: page 23, line 29 – page 24, line 1.) The Specification goes on to describe several examples of converting at least a portion of a secure audiovisual object into index information, including parsing a music file to identify lyrics, and employing optical character recognition software to identify one or more textual elements within a bitmap image. (Specification: page 24, lines 1-6.) In addition, as described with regard to states 512 and 514 of Figure 5, a server computer can select index information for the secure document by selecting textual portions of the source data object, such as was converted at state 512, or portions of the source data object that is already in textual form. (Specification: page 24, lines 20-26.)

Claim 1 further recites that the secure audiovisual object is secure, in that search engine systems do not have full access to the secure audiovisual object. For example, secure

documents, such as secure audio visual objects, may be protected by DRM software, or some other secure software. (Specification: page 3, lines 15-26.) Furthermore, such software does not permit unrestricted access, but restricts access to those applications that are both authorized and trusted by the secure software, and prevents all other applications from accessing the protected document, audiovisual object. (Specification: page 3, lines 23-26.)

Claim 1 further recites obfuscating at least a portion of the index information so that the intelligibility of the contents of the index information is reduced. For example, the server computer obfuscates the index information such that if the index information was viewed by a user, the user would not be able to easily reconstruct the original content of the source data object. (Specification: page 26, lines 1-7.) The obfuscation process is described in further detail with reference to Figure 10 in the Specification on page 28, line 27, through page 31, line 2.

Claim 1 further recites transmitting the obfuscated index information to the search engine system, wherein the obfuscated index information is for use in the index database of the search engine system. For example, a server computer can dynamically generate an electronic document that comprises the index information for the source data object, where the term "dynamical generates" includes transmitting a pre-prepared electronic document that is associated with the URL and that is customized for a selected requestor. (Specification: page 13, lines 1-8.) Furthermore, the server computer can transmit an electronic document having index or other descriptive information regarding the source data object. (Specification: page 15, lines 26-31.)

B. Claim 2

Claim 2 depends from claim 1. Claim 2 further recites dynamically generating an electronic document that comprises at least a portion of the obfuscated index information. For example, the term "dynamically generates" can include (i) preparing in real-time an electronic document or (ii) transmitting a pre-prepared electronic document that is associated with the URL and that is customized particularly for a selected requestor. (Specification: page 13, lines 5-8.)

C. Claim 3

Claim 3 depends from claim 2, which depends from claim 1. Claim 3 recites that dynamically generating the electronic document comprises customizing, based at least in part upon the indexing characteristics of one or more search engine systems, the content of the electronic document. For example, the server computer can generate customized index information on the fly based upon the indexing characteristics of the IR system. (Specification: page 37, lines 18-22.)

D. Claim 12

Claim 12 recites a computerized method of providing index information for secure graphical or audio objects. Claim 12 comprises reading index information that is associated with a secure graphical or audio object, wherein the index information is structured for use in an index database of a search engine system. For example, a software program called a “spider” surveys electronic resources that are stored by computers connected to a network, where an electronic resource can comprise a dynamically prepared electronic document that is the output of scripts of a server computer. (Specification: page 12, lines 16-21.)

Claim 12 further recites that search engine systems do not have full access to the secure graphical or audio object, and wherein search engine systems do not have access to said index information associated with said secure graphical or audio object. For example, secure documents, such as secure audio visual objects, may be protected by DRM software, or some other secure software. (Specification: page 3, lines 15-26.) Furthermore, such software does not permit unrestricted access, but restricts access to those applications that are both authorized and trusted by the secure software, and prevents all other applications from accessing the protected document, audiovisual object. (Specification: page 3, lines 23-26.)

Claim 12 further recites obfuscating at least a portion of the index information so that the intelligibility of the index information is reduced. For example, the server computer obfuscates the index information such that if the index information were viewed by a user, the user would not be able to easily reconstruct the original content of the source data object. (Specification: page 26, lines 1-7.) The obfuscation process is described in further detail with reference to Figure 10 in the Specification on page 28, line 27, through page 31, line 2.

Claim 12 further recites transmitting the obfuscated index information to the search engine system, wherein the obfuscated index information is for use in the index database of the search engine system. For example, a server computer can dynamically generate an electronic document that comprises the index information for the source data object, where the term “dynamical generates” includes transmitting a pre-prepared electronic document that is associated with the URL and that is customized for a selected requestor. (Specification: page 13, lines 1-8.) Furthermore, the server computer can transmit an electronic document having index or other descriptive information regarding the source data object. (Specification: page 15, lines 26-31.)

E. Claim 13

Claim 13 depends from claim 12. Claim 13 further recites dynamically generating an electronic document that comprises at least a portion of the obfuscated index information. For example, the term "dynamically generates" can include (i) preparing in real-time an electronic document or (ii) transmitting a pre-prepared electronic document that is associated with the URL and that is customized particularly for a selected requestor. (Specification: page 13, lines 5-8.)

F. Claim 14

Claim 14 depends from claim 12. Claim 14 recites that wherein dynamically generating the electronic document comprises customizing, based at least in part upon the indexing characteristics of one or more search engine systems, the content of the electronic document. For example, the server computer can generate customized index information on the fly based upon the indexing characteristics of the IR system. (Specification: page 37, lines 18-22.)

G. Claim 19

Claim 19 recites a system for generating index information for secure graphical or audio objects. Claim 19 comprises a web server connected to a network, the web server operable to manage a content owner's secure graphical or audio objects including granting and denying access to secure content requesters, wherein search engine systems are denied access to said objects. Referring to Appellants' Figure 1, the system operates in a computer network that provides a client/server environment, and generally includes a user 102, one or more servers 110, a client computer 115, and a computer network 116. (Specification: page 9, lines 9-14.)

The web server reads index information that is associated with a secure graphical or audio object, wherein the index information is structured for use in an index database of a search engine system. For example, a software program called a “spider” surveys electronic resources that are stored by computers connected to a network, where an electronic resource can comprise a dynamically prepared electronic document that is the output of scripts of a server computer. (Specification: page 12, lines 16-29.)

In addition, the secure graphical or audio object is secure in that the search engine system does not have full access to the secure graphical or audio object. For example, secure documents, such as secure audio visual objects, may be protected by DRM software, or some other secure software. (Specification: page 3, lines 15-26.) Furthermore, such software does not permit unrestricted access, but restricts access to those applications that are both authorized and trusted by the secure software, and prevents all other applications from accessing the protected document, audiovisual object. (Specification: page 3, lines 23-26.)

The web server also dynamically generates an electronic document based at least in part upon the contents of the index information. For example, the server computer dynamically generates an electronic document that comprises the index information for the source data object. (Specification: page 13, lines 1-8.)

Claim 19 further recites said web server transmitting the electronic document to the search engine system, wherein index information within the electronic document is for use in the index database of the search engine system. For example, a server computer can dynamically generate an electronic document that comprises the index information for the source data object, where the term “dynamical generates” includes transmitting a pre-prepared electronic document that is associated with the URL and that is customized for a selected requestor. (Specification: page 13, lines 1-8.) Furthermore, the server computer can transmit an electronic document having index or other descriptive information regarding the source data object. (Specification: page 15, lines 26-31.)

H. Claim 25

Claim 25 recites a computerized method of generating index information for secure graphical or audio objects. Claim 25 comprises converting at least a portion of a secure

graphical or audio object into index information, wherein the index information is structured for use in an index database of a search engine system. For example, as described in the Specification referring to state 512 of Figure 5, a server computer converts all or selected portions of the source data object into machine readable characters that will collectively comprise an initial set of index information for the source data object. (Specification: page 23, line 29 – page 24, line 1.) The Specification goes on to describe several examples of converting at least a portion of a secure audiovisual object into index information, including parsing a music file to identify lyrics, and employing optical character recognition software to identify one or more textual elements within a bitmap image. (Specification: page 24, lines 1-6.) In addition, as described with regard to states 512 and 514 of Figure 5, a server computer can select index information for the secure document by selecting textual portions of the source data object, such as was converted at state 512, or portions of the source data object that is already in textual form. (Specification: page 24, lines 20-26.)

Claim 25 further recites that search engine systems do not have full access to the secure graphical or audio object. For example, secure documents, such as secure audio visual objects, may be protected by DRM software, or some other secure software. (Specification: page 3, lines 15-26.) Furthermore, such software does not permit unrestricted access, but restricts access to those applications that are both authorized and trusted by the secure software, and prevents all other applications from accessing the protected document, audiovisual object. ((Specification: page 3, lines 23-26.)

Claim 25 further recites dynamically generating an electronic document based at least in part upon the contents of the index information. For example, the server computer dynamically generates an electronic document that comprises the index information for the source data object. (Specification: page 13, lines 1-8.)

Claim 25 further recites transmitting the electronic document to the search engine system, wherein index information within the electronic document is for use in a search-optimized index database of the search engine system. For example, a server computer can dynamically generate an electronic document that comprises the index information for the source data object, where the term “dynamical generates” includes transmitting a pre-prepared electronic document that is

associated with the URL and that is customized for a selected requestor. (Specification: page 13, lines 1-8.) Furthermore, the server computer can transmit an electronic document having index or other descriptive information regarding the source data object. (Specification: page 15, lines 26-31.)

I. Claim 26

Claim 26 depends from claim 25. Claim 26 recites that wherein dynamically generating the electronic document comprises customizing the electronic document, wherein the customizing is based at least in part upon the indexing characteristics of one or more of the search engine systems. For example, the server computer can generate customized index information on the fly based upon the indexing characteristics of the IR system. (Specification: page 37, lines 18-22.)

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 1-4, 12-15, 19-21, and 25-27 are unpatentable under 35 U.S.C. § 103(a) over allegedly Admitted Prior Art (“Appellants’ Background”) in view of U.S. Patent No. 6,070,158 (“Kirsch”).

2. Whether claims 5-11, 16-18, and 22-24 are unpatentable under 35 U.S.C. § 103(a) over allegedly Admitted Prior Art (“Appellants’ Background”) in view of U.S. Patent No. 6,070,158 (“Kirsch”) and in further view of U.S. Patent No. 6,243,713 (“Nelson”).

VII. ARGUMENT

I. Ground of Rejection No. 1: Claims 1-4, 12-15, 19-21, and 25-27 Are Patentable Over Appellants' Background In View Of Kirsch.

Independent claims 1, 12, 19, and 25 stand rejected under Section 103 as allegedly unpatentable over Appellants' Background in view of Kirsch. This rejection was first presented in an Office Action dated August 10, 2005. Appellants traversed the rejection, and it was then withdrawn. In the six office actions that followed the August 10, 2005 Office Action, no other rejection was based on Appellants' Background, until the Office Action dated February 3, 2009, from which this appeal is taken.

As discussed in detail below, Appellants' Background is not admitted prior art, is not an enabling disclosure, and clearly fails to teach or suggest the various recitations of Appellants' claims. Kirsch does not compensate for the deficiencies of Appellants' Background. Therefore, this honorable Board is respectfully urged to reverse all of the presently pending rejections.

A. The Combination of Appellants' Background And Kirsch Does Not Teach Or Suggest All Of The Recitations Of Appellants' Claims.

The alleged combination of Appellants' Background and Kirsch fails to teach or suggest numerous recitations of Appellants' claims. Appellants' Background is not an admission that prior art reads on Appellants' claims, but merely discusses how information retrieval systems do not have access to secure documents, and thus cannot index secure documents. (Appellants' Background, ¶¶ 7-9.) Kirsch fails to compensate for the deficiencies of Appellants' Background. Further, even if Kirsch were relevant to Appellants' claims, there is no rationale to support combining Kirsch with Appellants' Background. Accordingly, for any one of the independent reasons set forth below, the Examiner's rejections of Appellants' claims should be reversed.

1. Independent Claims 1, 12, and 25

- a) *“converting at least a portion of a secure audiovisual object into index information” and “reading index information that is associated with a secure graphical or audio object.”*

Independent claims 1 and 25 each recites in part “converting at least a portion of a secure audiovisual object into index information.” Independent claim 12 recites in part “reading index

information that is associated with a secure graphical or audio object.” The Examiner alleged that Appellants’ Background discloses the identified recitations in paragraphs 7-11 of Appellants’ Specification. (Office Action, pages 5, 9, and 11.) Specifically, the Examiner alleged that Appellants’ Background teaches that “the prior art includes information retrieval systems that index ‘documents’ protected by digital rights management software.” (Id.) To the contrary, as explained in detail below, Appellants’ Background discusses the problem that information retrieval systems *cannot* access, and therefore *cannot* index, secure documents. In addition, the Examiner did not allege, and Appellants’ Background does not teach, “converting” or “reading” objects that are “secure.” For at least these reasons, discussed further below, Appellants’ Background, either alone or in combination with Kirsch, does not teach or suggest “converting at least a portion of a *secure* audiovisual object into index information,” as recited in claims 1 and 25, or “reading index information that is associated with a *secure* graphical or audio object,” as recited in claim 12.

Appellants’ Background states that information retrieval systems “index documents by searching for keywords” within the documents. (Appellants’ Background, ¶ 7.) Appellants’ Background further states that “secure documents, such as documents that are protected by digital rights management (DRM) software, present a special problem for IR [information retrieval] systems.” (Appellants’ Background, ¶ 8.) Appellants’ Background further states that “[t]raditionally, IR systems rely upon having full access to the contents of the document to prepare the index information for the document . . . [s]ecure software, however, does not permit this kind of unrestricted access.” (Appellants’ Background, ¶¶ 7-8.)

Appellants’ Background then goes on to discuss a hypothetical solution of “retrofit[ing] all pre-existing IR systems so that they are ‘rights enabled.’” (Appellants’ Background, ¶ 10.) Appellants’ Background does not discuss how such a feat could be accomplished, nor does Appellants’ Background reference any “prior art” system capable of retrofitting all pre-existing IR systems. Instead, Appellants’ Background merely points to one approach, and then explicitly states that “this approach makes a number of unrealistic assumptions.” (Id.) At a minimum, Appellants’ Background fails to provide sufficient details to be considered an enabling disclosure. Indeed, far from being an enabling disclosure, Appellants’ Background states that the

concept of rights-enabled retrofits is based on “unrealistic assumptions.” Appellants’ Background is thus non-enabling on its face because it says that rights-enabled retrofits may not be possible to implement, rather than explaining how they could be implemented. Further, stating that a concept is based on unrealistic assumptions clearly teaches away from the concept, here rights-enabled retrofits. The rejections of Appellants’ claims should be reversed for at least these reasons.

Moreover, even if such a discussion could be considered “prior art,” Appellants’ Background fails to teach or suggest the identified recitations of independent claims 1, 12, or 25. For example, retrofitting an information retrieval system suggests nothing more than allowing a remote information retrieval system to access secure documents for indexing. As stated in Appellants’ Background, “[t]his solution permits IR systems to communicate directly with secure software to obtain the document source.” (Appellants’ Background, ¶ 10.) However, as also pointed out in Appellants’ Background, such a proposal is based on unrealistic assumptions, such as “that it is possible to establish the necessary trust relationships between every secure provider, copyright holder, and IR system provider” to enable each information retrieval system to access the secure documents that are protected by digital rights management (DRM) software of many different systems.

Clearly, such a hypothetical proposition, along with its attendant flaws, is not admitted prior art or an enabling disclosure. In addition, the cited portions of Appellants’ Background clearly fail to teach or suggest “converting at least a portion of a secure audiovisual object into index information” or “reading index information that is associated with a secure graphical or audio object,” as recited in independent claims 1, 12, and 25. Thus, Appellants’ Background fails to teach or suggest the identified recitations of independent claims 1, 12, or 25. Therefore, for at least the foregoing reasons, the rejections of claims 1, 12, and 25, and of their respective dependent claims, should be reversed.

b) “*wherein the index information is structured for use in an index database of a search engine system.*”

Independent claims 1, 12, and 25 each further recites in part that “the index information is structured for use in an index database of a search engine system.” The Examiner asserted that

Appellants' Background teaches this recitation by allegedly teaching that "keywords extracted from the protected 'documents' are 'structured for use in an index database of a search engine system.'" (Office Action, page 6.) However, as previously discussed, Appellants' Background merely discusses how information retrieval systems *cannot* access, and therefore *cannot* index, secure documents. For example, Appellants' Background states that "secure documents, such as documents that are protected by digital rights management (DRM) software, present a special problem for IR systems" because "IR systems rely upon having full access to the contents of the document to prepare the index information for the document." (Appellants' Background, ¶ 8.) Further, Appellants' Background states that "[s]ecure software . . . does not permit this kind of unrestricted access." (Appellants' Background, ¶ 9.)

To the extent that Appellants' Background teaches anything, Appellants' Background merely states that "[i]nformation retrieval (IR) systems index documents by searching for keywords that are contained within the documents . . . [and that] words are extracted from the document and are then indexed in separate data structures optimized for searching." (Appellants' Background, ¶ 7.) Thus, as discussed above, Appellants' Background fails to teach "converting at least a portion of a secure audiovisual object into index information," and thus cannot teach that the "index information is structured for use in an index database."

Therefore, for at least this reason, the rejections of claims 1, 12, and 25, and of their respective dependent claims, should be reversed.

2. Independent Claims 1 and 12

a) *"obfuscating at least a portion of the index information so that the intelligibility of the contents of the index information is reduced."*

Independent claims 1 and 12 each recites in part "obfuscating at least a portion of the index information so that the intelligibility of the contents of the index information is reduced." The Examiner admitted that Appellants' Background fails to teach the identified recitation. The Examiner then cited Kirsch as allegedly compensating for the acknowledged deficiencies of Appellants' Background. (Office Action, page 7.) Further, the Examiner alleged that "there are many references in the prior art that may be interpreted to cover this claimed feature of the present invention." (Id.) However, the Examiner did not identify, much less base a rejection of

claims 1 and 12 on, any reference other than Appellants' Background and Kirsch. As discussed below, Kirsch, whether viewed alone or in combination with Appellants' Background, does not teach or suggest "obfuscating at least a portion of the index information so that the intelligibility of the contents of the index information is reduced."

Kirsch is directed to a search engine that indexes unprotected or unsecured documents. Specifically, Kirsch is directed to "document search engines utilizing text based queries to identify query related relevant documents." (Kirsch: col. 1, lines 31-33.) Kirsch states that batch updates to the index database "are collected through the operation of a Web spider that incrementally searches the Web for new and changed documents." (Kirsch: col. 6, lines 4-10.) However, secure documents, such as those protected by DRM, are not accessible by web spiders. Kirsch recognizes this fact and states that "[d]ocuments determined to be unavailable by the Web spider are noticed for deletion from the search site index." (Kirsch: col. 6, lines 10-12.) Thus, Kirsch actually teaches away from Appellants' claims by teaching a search engine system that *deletes* inaccessible documents (i.e. secure documents) from the index.

The Examiner alleged that Kirsch teaches "obfuscating at least a portion of the index information so that the intelligibility of the contents of the index information is reduced" and pointed to Kirsch's Figures 3-6 and column 9, line 40 through column 11, line 7. (Office Action, page 7.) Specifically, the Examiner alleged that "Kirsch teaches this limitation in that the 'stop list' terms are filtered and removed from the content of the document." (Id.) However, Kirsch explicitly states that the purpose of the "stop list" is to "eliminate terms that do not or are unlikely to carry contextual significance," such as conjunctions, passive verb forms, and "[s]imple titles such as Mr. and Mrs." (Kirsch: col. 10, lines 20-24.) As opposed to "*obfuscating* at least a portion of the *index information*," Kirsch discusses preparing index information by *removing* frequently occurring *words from select phrases within the document*. Further, Kirsch states that "[a]fter qualification by the word stop list 70, any remaining simple terms are passed to a search term list 84." (Kirsch: col. 12, lines 13-15.) Thus, once excess words are removed, the remainder is passed to a search term list.

Accordingly, Kirsch does not teach or suggest obfuscating information at all, much less "obfuscating at least a portion of the index information." At most, Kirsch teaches to "eliminate

terms that do not or are unlikely to carry contextual significance.” (Kirsch: col. 10, lines 20-22.) That is, Kirsch does not teach “that the intelligibility of the contents of the index information is reduced,” as recited in Appellants’ claims, but rather teaches maximizing the intelligibility of the contents of index information by removing, rather than obfuscating, excess words and phrases. In addition, none of the other cited portions of Kirsch teach or suggest the identified recitation of claims 1 and 12. Further, as discussed in more detail below, Kirsch teaches indexing unsecured, publicly available documents, and thus has no need to obfuscate any portion of the index information.

Therefore, for at least this reason, the rejections of claims 1 and 12, and of their respective dependent claims, should be reversed.

b) “transmitting the obfuscated index information to the search engine system, wherein the obfuscated index information is for use in the index database of the search engine system.”

The Examiner admitted that Appellants’ Background fails to teach the recitation in claims 1 and 12 of “transmitting the obfuscated index information to the search engine system, wherein the obfuscated index information is for use in the index database of the search engine system.” However, the Examiner failed to even allege that Kirsch compensates for the deficiencies of Appellants’ Background, let alone state how or where Kirsch teaches the identified recitation. (See Office Action, pages 7-8.) Therefore, the rejections of claims 1 and 12 should be reversed at least because the Examiner has failed to state a *prima facie* case of obviousness.

Obviousness is a question of law based upon several factual inquiries, namely, the scope and content of the cited references, the differences between the cited references and the claims, and the level of ordinary skill in the art. (*Graham v. John Deere Co.*, 383 U.S. 1 (1966); see also MPEP § 2141(II).) The United States Supreme Court reaffirmed the requirement to make these factual inquiries in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). Further, the “[r]ejection of a patent on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support a legal conclusion of obviousness.” *KSR* at 417. Thus, the Examiner is required to

provide some rationale to support a rejection based on obviousness. Because the Examiner has not done so, the Examiner's rejections must be reversed.

Further, Kirsch does not teach or suggest Appellants' foregoing claim recitations. The Examiner alleged that it would have been obvious to modify Appellants' Background with the alleged teachings of Kirsch "for the purpose of selectively securing the data in the 'index information,' as taught by Kirsch." (Office Action, page 8.) However, Kirsch does not teach "selectively securing the data in the 'index information.'" Further, Kirsch explicitly states that Kirsch's disclosed search engine *cannot access, and therefore cannot index*, secure documents. Instead, Kirsch teaches indexing unsecured, publicly available documents. Therefore, not only does Kirsch fail to teach or suggest the recitations of Appellants' claims, but Kirsch would have had no reason to secure the index information or obfuscate the data in the index, as Kirsch's documents themselves are unsecured and publicly available.

For at least the foregoing reasons, the rejections of independent claims 1 and 12, and of their respective dependent claims, should be reversed.

3. Independent Claim 19

Independent claim 19 is directed to "[a] system for generating index information for secure graphical or audio objects." Claim 19 was also rejected as unpatentable over Appellants' Background in view of Kirsch. (Office Action, pages 9-10.) However, the combination of Appellants' Background and Kirsch fails to teach or suggest numerous recitations of claim 19. Further, as previously discussed, there is no rationale to support combining Kirsch with Appellants' Background. Accordingly, for any one of the independent reasons set forth below, the Examiner's rejections of Appellants' claims should be reversed.

- a) *"a web server connected to a network, said web server operable to manage a content owner's secure graphical or audio objects including granting and denying access to secure content requesters, wherein search engine systems are denied access to said objects."*

Claim 19 recites in part "a web server connected to a network, said web server operable to manage a content owner's secure graphical or audio objects including granting and denying access to secure content requesters, wherein search engine systems are denied access to said

objects.” The Examiner alleged that Appellants’ Background teaches “the use of a web server” in paragraph 8. (Office Action, page 10.) However, the Examiner failed to allege that Appellants’ Background teaches the foregoing recitation of claim 19. (See Office Action, page 10.) Thus, the rejection of claim 19 should be reversed at least because the Examiner failed to state a *prima facie* case of obviousness.

Moreover, Appellants’ Background in no way teaches or suggests the foregoing recitation of claim 19. In paragraph 8, Appellants’ Specification states that “secure documents, such as documents that are protected by digital rights management (DRM) software, present a special problem for IR systems.” Further, paragraph 8 of Appellants’ Specification states that “[t]raditionally, IR systems rely upon having full access to the contents of the document to prepare the index information for the document. For example, IR systems that index HyperText Markup Language (HTML) documents on the Internet typically open each HTML document via its Uniform Resource Locator (URL), then download, parse, and index the entire document.” However, Appellants’ Background says nothing about a “web server operable to manage a content owner’s secure graphical or audio objects,” as recited in claim 19. Further, Appellants’ Background fails to teach or suggest “granting and denying access to secure content requesters, wherein search engine systems are denied access to said objects.” Further, as discussed above with respect to claim 1, Kirsch fails to compensate for the deficiencies of Appellants’ Background.

Therefore, for at least this reason, the rejection of claim 19, and of claims 20-24 depending therefrom, should be reversed.

b) “said web server reading index information that is associated with a secure graphical or audio object, wherein the index information is structured for use in an index database of a search engine system.”

Independent claim 19 further recites in part “said web server reading index information that is associated with a secure graphical or audio object, wherein the index information is structured for use in an index database of a search engine system.” The Examiner did not allege that Appellants’ Background teaches “said web server reading index information that is associated with a secure graphical or audio object,” as recited in claim 19. Thus, the rejection of

claim 19 should be reversed at least because of this further failure to state a *prima facie* case of obviousness.

Moreover, Appellants' Background in no way teaches or suggests the foregoing recitation of claim 19. To the contrary, as discussed above with respect to claim 1, Appellants' Background explains that information retrieval systems cannot access, and therefore cannot index, secure documents. Therefore, Appellants' Background fails to teach or suggest "said web server reading index information that is associated with a secure graphical or audio object," as recited in claim 19. Further, Appellants' Background fails to teach or suggest that "the index information is structured for use in an index database of a search engine system." Further, as discussed above with respect to claim 1, Kirsch fails to compensate for the deficiencies of Appellants' Background.

Therefore, for at least this reason, the rejection of claim 19, and of claims 20-24 depending therefrom, should be reversed.

c) *"dynamically generating an electronic document based at least in part upon the contents of the index information."*

Independent claim 19 further recites "dynamically generating an electronic document based at least in part upon the contents of the index information." The Examiner alleged that Appellants' Background teaches "the web server generating an electronic document based at least in part upon the contents of the index information." (Office Action, page 10.) However, for at least the reasons discussed above, Appellants' Background has no such disclosure. For example, Appellants' Background discusses how information retrieval systems cannot access, and therefore cannot index, secure documents. Further, Appellants' Background discusses a hypothetical system where information retrieval systems are retrofitted to have access to secure documents. However, Appellants' Background says nothing about "generating an electronic document based at least in part upon the contents of the index information," as recited in claim 19.

The Examiner then admitted that Appellants' Background fails to teach "the web server **dynamically** generating an electronic document based at least in part upon the contents of the index information." (Office Action, page 10; emphasis in original.) The Examiner then alleged,

with no explanation, that Kirsch teaches the identified recitation in column 10, line 18 through column 12, line 49, and in Figures 3 and 4. (Id.) In particular, the Examiner did not explain how Kirsch's search engine system relates to a "web server dynamically generating an electronic document," as recited in claim 19.

Kirsch is directed to a "collection search system [that] includes a collection index . . . a linguistic parser . . . and a search engine coupled to receive the list from the linguistic parser." (Kirsch: Abstract.) Kirsch discusses various aspects of a search engine, and not a web server. For example, Kirsch discusses eliminating words and phrases "that do not or are unlikely to carry contextual significance." (Kirsch" col. 10, lines 18-22.) Further, Kirsch discusses how "simple terms identified by the sentence analyzer 68 are provided to a term filter 72 for relevance screening," and also states that "[a] word stop list 70 is utilized by the term filter 72 to eliminate terms that do not or are unlikely to carry contextual significance." (Kirsch: col. 10, lines 18-23.) Kirsch also discusses "the processing of a client query 40" and discusses how "[c]lient query terms 82 are first passed to a sentence analyzer 68 for syntactic analysis." (Kirsch: col. 11, line 66 – col. 12, line 3.)

Appellants' Background, on the one hand, merely discusses how information retrieval systems cannot access secure documents. Kirsch, on the other, teaches at most a search engine that downloads web pages and indexes the words on each web page. Clearly neither Appellants' Background, nor Kirsch, teaches or suggests "dynamically generating an electronic document based at least in part upon the contents of the index information," as recited in claim 19.

Therefore, for at least this reason, the rejection of claim 19, and of claims 20-24 depending therefrom, should be reversed.

d) No Reason to Combine Kirsch with Appellants' Background.

The Examiner alleged that it would have been obvious to modify Appellants' Background with the alleged teachings of Kirsch "because it would have allowed for and well supports the parallel search of multiple and distributed document collection indexes, and allowed new documents to be dynamically integrated into the searchable collections through parallel extension of any search to include a real-time updatable document collection index." (Office

Action, page 10.) However, the provided rationale is nothing more than a brief synopsis of Kirsch's Summary of the Invention (e.g., column 4, lines 30-35), and has nothing to with claim 19 or Appellants' Background. Claim 19 is directed to "[a] system for generating index information for secure graphical or audio objects." Further, Appellants' Background discusses how information retrieval systems cannot access, and therefore cannot index, secure documents. Combining the search engine system of Kirsch would not solve the problem discussed in Appellants' Background, as even Kirsch notes that its disclosed search engine cannot index secure documents. As such, one would not have combined Kirsch with Appellants' Background. Further, even if there were some reason to combine Kirsch with Appellants' Background, the resulting combination still fails to teach or suggest the various recitations found in Appellants' claims.

For at least the foregoing reasons, the rejection of independent claim 19, and of claims 20-24 depending therefrom, should be reversed.

4. Dependent Claims 2 and 13

a) *"dynamically generating an electronic document which comprises at least a portion of the obfuscated index information"*

Claim 2 depends from claim 1, and claim 13 depends from claim 12. Claims 2 and 13 each recites in part "dynamically generating an electronic document which comprises at least a portion of the obfuscated index information." The Examiner's rejection of claim 13, which was also applied to claim 2, asserted that Kirsch teaches the foregoing recitation in column 10, line 18 through column 12, line 49, and in Figures 3 and 4. (Office Action, page 8.) With respect to claim 1, the Examiner alleged that Kirsch teaches "obfuscating at least a portion of the index information" by teaching "that the 'stop list' terms are filtered and removed from the content of the document." (Office Action, page 7.) However, Kirsch says nothing at all about using a "stop list" for anything other than identifying and removing words and phrases that don't have any contextual significance, such as conjunctions, passive verb forms, and "[s]imple titles such as Mr. and Mrs." (Kirsch: col. 10, lines 20-24.) Thus, Kirsch cannot teach "dynamically generating an electronic document which comprises at least a portion of the obfuscated index information," as recited in claims 2 and 13. Further, neither Appellants' Background nor Kirsch teach or suggest "generating an electronic document which comprises at least a portion of the

obfuscated index information.” At most, Kirsch teaches discarding words and phrases, while Appellants’ Background discusses how information retrieval systems cannot index secure documents.

For at least the foregoing reasons, the rejections of claim 2 and 13, and any claims depending therefrom, should be reversed.

5. Dependent Claims 3, 14, 20, and 26

- a) “customizing the electronic document, wherein the customizing is based at least in part upon the indexing characteristics of one or more of the search engine systems.”**

Claim 3 depends from claim 2, which depends from claim 1, and claim 14 depends from claim 12. Each recites “wherein dynamically generating the electronic document comprises customizing, based at least in part upon the indexing characteristics of one or more search engine systems, the content of the electronic document.” Claim 20 depends from claim 19, and claim 26 depends from claim 25. Each recites “wherein dynamically generating the electronic document comprises customizing the electronic document, wherein the customizing is based at least in part upon the indexing characteristics of one or more of the search engine systems.”

With respect to claim 3, the Examiner merely alleged that Kirsch teaches the identified recitations in columns 10-12. The Examiner did not explain how or where Kirsch teaches the various foregoing recitations. As previously discussed, Kirsch fails to teach “dynamically generating an electronic document,” and therefore cannot teach or suggest the identified recitations. For example, Kirsch fails to teach or suggest “customizing, based at least in part upon the indexing characteristics of one or more search engine systems, the content of the electronic document,” as the cited portions of Kirsch fail to teach or suggest performing anything “based . . . upon the indexing characteristics of one or more search engines.” Instead, the cited portions of Kirsch, e.g. columns 10-12, merely discusses various aspects of a search engine, such as eliminating words and phrases “that do not or are unlikely to carry contextual significance.” (Kirsch” col. 10, lines 18-22.) Further, because Kirsch is directed to a search engine, Kirsch would have no need to customize anything “based . . . upon the indexing characteristics of one or more search engine systems,” as recited in dependent claims 3, 14, 20, and 26.

For at least the foregoing reasons, the rejections of claims 3, 14, 20, and 26 should be reversed.

II. Ground of Rejection No. 2: Claims 5-11, 16-18, and 22-24 Are Patentable Over Appellants' Background In View Of Kirsch and Nelson.

Dependent claims 5-11, 16-18, and 22-24 are each patentable at least because each depends from a patentable independent claim. However, each also recites independently patentable subject matter. For the reasons stated above, neither Appellants' Background nor Kirsch, either alone or in combination, teaches or suggests numerous recitations of Appellants' claims. In addition, Nelson fails to compensate for the deficiencies of Appellants' Background and Kirsch. Therefore, dependent claims 5-11, 16-18, and 22-24 are allowable over the cited references, and the rejections of these claims should be reversed for at least the foregoing reasons.

CONCLUSION

In view of the foregoing arguments, Appellants respectfully submit that the pending claims are patentable over the cited references. The Examiner's rejections of all pending claims are improper because the cited references do not teach or suggest each and every element of the claimed invention. In view of the above analysis, a reversal of the rejections of record is respectfully requested of this Honorable Board.

It is believed that any fees associated with the filing of this paper are identified in an accompanying transmittal. However, if any additional fees are required, they may be charged to Deposit Account 18-0013, under Order No. 66703-0002, from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. 1.136(a) is hereby made, the fee for which should be charged against the aforementioned account.

Dated: June 24, 2009

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APPENDIX A – CLAIMS ON APPEAL

Pursuant to 37 CFR § 41.37(c)(vii), the following is a listing of the claims involved in the appeal.

1. A computerized method of providing index information for secure audiovisual objects to a search engine system, the method comprising:

converting at least a portion of a secure audiovisual object into index information, wherein the index information is structured for use in an index database of a search engine system, and wherein the secure audiovisual object is secure in that search engine systems do not have full access to the secure audiovisual object;

obfuscating at least a portion of the index information so that the intelligibility of the contents of the index information is reduced; and

transmitting the obfuscated index information to the search engine system, wherein the obfuscated index information is for use in the index database of the search engine system.

2. The method of claim 1, additionally comprising dynamically generating an electronic document which comprises at least a portion of the obfuscated index information.
3. The method of claim 2, wherein dynamically generating the electronic document comprises customizing, based at least in part upon the indexing characteristics of one or more search engine systems, the content of the electronic document.
4. The method of claim 2, wherein the electronic document comprises a HyperText Markup Language (HTML) file.

5. The method of claim 2, wherein the secure audiovisual object comprises a bitmap image.
6. The method of claim 2, wherein the secure audiovisual object comprises music.
7. The method of claim 6, wherein converting at least a portion of the secure audiovisual object into index information text comprises identifying one or more words in the lyrics of the music.
8. The method of claim 1, wherein the secure audiovisual object comprises a multimedia presentation.
9. The method of claim 8, wherein converting at least a portion of the secure audiovisual object into index information comprises reading close captioned information that is associated with the secure audiovisual object.
10. The method of claim 1, wherein the secure audiovisual object comprises a streaming media file.
11. The method of claim 1, wherein converting at least a portion of the secure audiovisual object into index information comprises reading close captioned information that is associated with the secure audiovisual object.
12. A computerized method of providing index information for secure graphical or audio objects, the method comprising:

reading index information that is associated with a secure graphical or audio object, wherein the index information is structured for use in an index database of a search engine system, and wherein search engine systems do not have full access to the secure graphical or audio object, and wherein search engine systems do not have access to said index information associated with said secure graphical or audio object;

obfuscating at least a portion of the index information so that the intelligibility of the index information is reduced; and

transmitting the obfuscated index information to the search engine system, wherein the obfuscated index information is for use in the index database of the search engine system.

13. The method of claim 12, additionally comprising dynamically generating an electronic document which comprises at least a portion of the obfuscated index information.

14. The method of claim 12, wherein dynamically generating the electronic document comprises customizing, based at least in part upon the indexing characteristics of one or more search engine systems, the content of the electronic document.

15. The method of claim 12, wherein the electronic document comprises a HyperText Markup Language (HTML) file.

16. The method of claim 12, wherein the secure graphical object comprises a bitmap image.

17. The method of claim 12, wherein the secure graphical object is a multimedia presentation.

18. The method of claim 12, wherein the secure graphical object is a streaming media file.

19. A system for generating index information for secure graphical or audio objects, the system comprising:

a web server connected to a network, said web server operable to manage a content owner's secure graphical or audio objects including granting and denying access to secure content requesters, wherein search engine systems are denied access to said objects;

said web server reading index information that is associated with a secure graphical or audio object, wherein the index information is structured for use in an index database of a search engine system, and wherein the secure graphical or audio object

is secure in that the search engine system does not have full access to the secure graphical or audio object;

said web server dynamically generating an electronic document based at least in part upon the contents of the index information; and

said web server transmitting the electronic document to the search engine system, wherein index information within the electronic document is for use in the index database of the search engine system.

20. The method of claim 19, wherein dynamically generating the electronic document comprises customizing the electronic document, wherein the customizing is based at least in part upon the indexing characteristics of one or more of the search engine systems.

21. The method of claim 19, wherein the electronic document comprises a HyperText Markup Language (HTML) file.

22. The method of claim 19, wherein the secure graphical object comprises a bitmap image.

23. The method of claim 19, wherein the secure graphical object is a multimedia presentation.

24. The method of claim 19, wherein the secure graphical object is a streaming media file.

25. A computerized method of generating index information for secure graphical or audio objects, the method comprising:

converting at least a portion of a secure graphical or audio object into index information, wherein the index information is structured for use in an index database of a search engine system, and wherein search engine systems do not have full access to the secure graphical or audio object;

dynamically generating an electronic document based at least in part upon the contents of the index information; and

transmitting the electronic document to the search engine system, wherein index information within the electronic document is for use in a search-optimized index database of the search engine system.

26. The method of claim 25, wherein dynamically generating the electronic document comprises customizing the electronic document, wherein the customizing is based at least in part upon the indexing characteristics of one or more of the search engine systems.

27. The method of claim 25, wherein the electronic document comprises a HyperText Markup Language (HTML) file.

APPENDIX B – EVIDENCE APPENDIX

In this Appeal, Appellants do not rely on any evidence submitted pursuant to 37 CF.R.F. §§ 1.130, 1.131, or 1.132, or on any other evidence entered by the Examiner.

APPENDIX C – RELATED PROCEEDINGS APPENDIX

Not applicable – no related proceedings are referenced herein.